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09/881,353	06/12/2001	Farhad Mohit	BIZ/01-0003	8754
22874	7590	10/03/2007		
GANZ LAW, P.C. P O BOX 2200 HILLSBORO, OR 97123			EXAMINER CASLER, TRACI	
			ART UNIT	PAPER NUMBER
			3629	
			MAIL DATE	DELIVERY MODE
			10/03/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

### Application No.

09/881,353

### Applicant(s)

MOHIT ET AL.

### Examiner

Traci L. Casler

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 June 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-59, 64-67 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-59 and 64-67 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

This action is in response to papers filed on June 22, 2007.

Claims 1-59 and 64-67 are pending.

Claims 33, 53 and 54 have been amended.

Claims 1-59 and 64-67 have been rejected.

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1-59 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent 6,581,065 Dynamic Insertion and Updating of Hypertext Links for Internet Servers; Rodkin et al. Hereinafter referred to as Rodkin.

3. As to claims 1, 20, 22, 27, 45 and 48-49 Rodkin teaches

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- Electronic documents stored by a content provider, embedding code executable by a client computer to invoke the central computer system to recognize key elements based on key elements contained in a key-element list.(C. 12 I. 45-49).
- Recognizing key elements in the document based on the key elements in the key element list(C. 11 I. 29-31& I. 62-64)
- Generating annotation instructions for the client computer system to create one or more annotations for one or more key elements in the content document and sending the instructions to the client computer system.(C. 12 I. 39-42)

4. As to claims 2-4, 26, 29-30, 32 and 46 Rodkins teaches code embedded into a document by a computer system(C. 13 I. 18-20 C. 13 I. 27-50). As to applicants specific limitations as to which computer system embeds the code onto the document this is non-functional descriptive material. The step proceeding the embedding are performed the same regardless of which computer embeds the code. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see in re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 44(Fed. Cir. 1983); In re Lowry, 32 F.3d 1579, 32 USPQ 2d 1031(Fed. Cir. 1994).

5. As to claims 5, 28, 31, 52 and 55 Rodkins teaches annotations associated with key words or phrases uses in a query(C. 13 I. 52-53)

6. As to claims 6-9, 34-38, 47 and 51 Rodkins teaches using the key elements, words or phrases to retrieve additional information or web pages based on user

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9. Selection of an annotation (C. 15 I. 48-54; C. 16 I. 2-5). As to applicant's limitations of the types of additional information that is retrieved from the user selected annotation, this limitation is non-functional descriptive material. Regardless if the information is purchase information, historical information, news articles, the retrieval process will be the same no matter the type of information being retrieved. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *in re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 44 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ 2d 1031 (Fed. Cir. 1994).

7. As to claims 10-12, 18-19, 21, 23-25 and 39-44, 50 Rodkin teaches information that is provided in the target document has means for electronically retrieving additional information (C. 16 I. 31-34)

8. As to claims 13-15 Rodkin teaches the user's selection of an annotation causes the retrieval of additional information. Again, the examiner notes the type of information being retrieved is non-functional descriptive material. The steps of retrieval will not be altered or differ based on the type of "content" being retrieved. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *in re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 44 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ 2d 1031 (Fed. Cir. 1994). As to claim 16 Rodkin teaches recognizing by the central computer (C. 18 I. 54-58)

9. As to claim 17 Rodkin teaches annotation being generated by the central computer. (C. 18 I. 65- C. 19 I. 6)

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10. As to claims 56-58 Rodkin teaches the server as a content server, a third party, and a central server(three separate systems)( C.11 I. 26-30 and C. 13 I. 11-14)

***Claim Rejections - 35 USC § 102***

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

12. Claims 33, 53-54 and 64-67 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent 6,289, 362 Van Der Meer; System and Method for Generating, Transferring and Using an Annotated Universal Address.

13. As to claims 33, 53, 64 and Van Der Meer teaches a system and method for generating annotation instructions

14. electronic document with code to be executed by the client system to recognized key elements(C. 4 I. 21-24; C. 5 I. 1-5). (content server has document that diary server embeds java script with is used by client to display document)

15. recognizing key elements(C. 5 I. 29-35) \*\*examiner notes applicant does not positively recite which system is recognizing key elements\*\*

16. generating annotation instructions and sending instructions to client(C. 12 I. 12-

17\*\*\* examiner notes applicant is not positively claiming the annotation of document\*\*

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- the central server(diary server) recognized key elements not previously annotated(C. 8 I. 4-8).

17. As to claims 54 and 65 Van Der Meer teaches

- A consumer retrieving an electronic document from content provider(third party, remote) C. 5 I. 3-5)
- a central computer sending instructions for presenting the user with hyperlinks to key elements(C. 6 I. 65-67; C. 7 I. 1-5)
- where in the annotations we not previously identified(C. 8 I. 4-8).
- annotations being created by client(C. 12 I. 12-17).

### ***Response to Arguments***

18. Applicant's arguments filed June 22, 2006 have been fully considered but they are not persuasive.

19. As applicants arguments regarding claim 1, applicant argues that Rodkin fails to teach the recognition and annotation by the proper/correct system. The examiner notes the applicant does not positively claim which system is recognizing and/or annotating nor is the actual annotation claimed. The Applicant simply claims that code is transmitted to annotate but not that any annotation has taken place by any of the systems. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., annotation and recognition by specific system) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from

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the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

20. As to applicants regarding claim 20, that Rodkin fails to teach "first computer system receives a web page corresponding to a web page presented to a user". The examiner first notes applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. Secondly, the examiner notes that Rodkin discloses the transmission of URL's ( ie, webpages) which both a first and second computer receive and display, the applicant does not claim an order in which any of the steps are taking place, therefore, the limitations are met as far as a first computer received a web page that was, is, will be displayed to a second computer.

21. As to applicants arguments regarding claim 22 and 49, that Rodkin fails to teach a key list from a remote system, In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., annotation) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). In response to applicant's argument that annotation, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of



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performing the intended use, then it meets the claim. The applicants claims merely indicate how the code could be used, how applicant intends for the client system to perform but never claims the performance of any of these recitations.

22. As to applicants arguments regarding claim 27, that Rodkin fails to teach the claim language. Applicant argues the "client and central" computers again are not properly identified, however, applicant fails to identify any of the systems, applicant merely has a general first and second system. The examiner further notes that applicant fails to argue how applicants claim language distinguishes itself, applicant merely repeats claim language and Rodkin excerpts and states there is no teaching not why Rodkin doesn't teach the claim language.

23. As to applicants arguments regarding claim 45, that Rodkin fails to teach annotation and recognition as positively recited steps that actually take place, the examiner again notes applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., recognition and annotation) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

24. As to applicants arguments regarding claim 48, that Rodkin does not teach which system is performing the recognition. The examiner notes that applicants claim fails to address any "recognition" process let alone which system performs the process.

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25. Applicant's arguments with respect to claims 33, 53-54 and 64-67 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

26. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

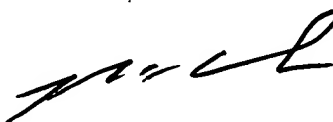
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Traci L. Casler<sup>9</sup> whose telephone number is 571-272-6809. The examiner can normally be reached on Monday-Thursday 6:00 am-4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TLC  


  
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